

Remarks

Priority of the captioned application has been denied primarily on the basis that the invention claimed in the captioned application is distinct from that of the disclosure of 09/269,989, the parent of the captioned application. The Examiner has taken the position that the disclosure of 09/269,989 provides no support for the subject matter disclosed and claimed in the captioned application. The Examiner's position in this regard is respectfully traversed.

With respect to the parent application, Serial No. 09/269,989, that application including claims supporting the present claims, was filed on May 1, 2000. That filing was in response to a Notification of Missing Requirements and a Notice of Defective Translation. On July 13, 2000, the Office issued a Communication Re Notification of Abandonment in which a prior Notification of Abandonment was vacated. Additionally, the Communication stated that applicant's claim for priority was acknowledged and that the application had an international filing date of 27 September 1997 (U.S. filing date) under 35 U.S.C. 363, and a date of 1 May 2000 under 35 U.S.C. 371(c) and 102(e)).

Unfortunately, subsequently claims were submitted via a Supplemental Preliminary Amendment which were not supported by the specification of Serial No. 09/269,989. Nonetheless, in an Office Action dated February 2, 2001, these claims were acted on on the merits, neither the Examiner nor the undersigned at that point realizing that these claims were from another co-pending application, namely Serial No. 09/269,992. In a teleconference with the Examiner the undersigned explained that the wrong claims had been submitted in the Supplemental Preliminary Amendment and this was confirmed in an Amendment of June 7, 2001 which was responsive to the Office Action of February 2, 2001. In that Amendment, the

erroneous claims were cancelled and Claims 53-72 substantially the same claims as those of the captioned application, were submitted. For the Examiner's convenience, a copy of the first page of the remarks accompanying the Amendment of June 7, 2001 are attached hereto. The first paragraph of the attached page sets out the facts surrounding the error.

Responsive to the June 7, 2001 Amendment, the Examiner issued an Office Action stating that newly submitted claims 53-72 were directed to an invention that is independent and distinct from the invention originally claimed. However, the Office Action acknowledged that the response was a bona fide attempt to reply and that applicant would be given a time period of one month or thirty (30) days to supply the admission or correction in order to avoid abandonment. In a subsequent teleconference with the Examiner, and after applicant's understanding that the Examiner had consulted with her supervisor, the Examiner advised the undersigned that the best course of action would be to file a continuation application with a preliminary amendment submitting claims the same as Claims 53-72 which, as noted, had previously been submitted in the Amendment of June 7, 2001 in connection with serial no. 09/269,989.

The continuation application i.e. the captioned application was filed on January 23, 2002 together with a Preliminary Amendment with claims 53-72. Subsequently, because of the numbering problem, a Preliminary Amendment was filed, the Preliminary Amendment containing Claims 22-41 which were the same as Claims 53-72 which had been submitted with the Amendment of June 7, 2001 in connection with serial no. 09/269,989.

A review of original claims 1-21 of application Serial No. 09/269,989 with pending claims 22-41 reveals that claims 22-41 basically incorporate the subject matter of claims 1-21

of application Serial No. 09/269,989. More importantly, Claims 22-41 are unequivocally supported by the disclosure of Serial No. 09/269,989, the parent of the captioned application.

Accordingly, while the undersigned would admit to confusion, at every juncture in this tortured path, there was an honest attempt to respond to any outstanding Office Action. In any event, there is no basis upon which applicant should be denied priority since the disclosure of the captioned application is identical to that of application Serial No. 09/269,989 and the claims of the captioned application find explicit support in that application. It is respectfully submitted that applicant has complied with all conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120.

Turning to the art rejections, Claims 22-26, 28-30, 32-34, 36 and 38-40 stand rejected as anticipated by EP O 669 162 (EP162). The rejection is respectfully traversed. EP162 does not disclose or suggest an aluminum/silicon ratio as recited in Claim 42 i.e. 99.5 wt. %: 0.5 wt. % to 50 wt. %: 50 wt. %: each referring to Al_2O_3 : SiO_2 . To the contrary EP162 teaches to use less than 40 wt. % Al_2O_3 . Accordingly, the alumino silicate compounds prepared according to EP162 comprise predominately SiO_2 . See also Table 1 of EP162. Additionally, no where in EP162 is there a teaching or suggestion that the alumino-silicate produced can be dispersed in an aqueous or aqueous-acidic media. It is respectfully submitted that Claims 42, 23-26, 28-30, 30-34, 36 and 38-40 are clearly patentable over EP162.

Claim 27 stands rejected as obvious over EP162, further in view of JP 1-197311. The rejection is respectfully traversed. The Japanese reference does not teach a hydrolysis temperature of 50-98°C but rather it employs a temperature of 30°C in all of the examples. Nor is it taught or suggested in the Japanese reference to jointly subject the reaction products

to hydrothermal aging in an aqueous-acidic environment at temperatures of 80 to 220°C. Furthermore, the Japanese reference does not cure the infirmities of EP162 as discussed above. It is respectfully submitted that Claim 27 is patentable over EP162 in view of the Japanese reference.

Claim 50(*sic*) is rejected as being anticipated or in the alternative obvious over any of the EP162, Meyer *et al* or White *et al* or Noweck *et al*. This rejection is not understood as there is no Claim 50 pending in the application. As stated on the second page of the Office Action, Claims 22-41 are pending, Claims 20-30, 32-36 and 38-40 being rejected, Claims 31, 37 and 41 being objected to. In paragraph four of the Office Action as noted above, Claims 22-26, 28-35, 32-34, 36 and 38-40 have been rejected. In Paragraph 6, Claims 22-26, 28-30, 32, 44, 36 and 38-40 have been rejected. Piecing together the rejection in those two paragraphs e.g. paragraphs 4 and 6 of the Office Action, and taking into account the allowable subject matter of Claims 31, 37 and 41, there appears to be no action as to Claim 35. Accordingly, for purposes of responding to the Office Action, it is assumed that the rejection in paragraph 7 is directed towards Claim 35, and assuming that that is true, the rejection is respectfully traversed. The infirmities of EP162 have been discussed above and it is not seen how the alumino-silicates of Claim 35 are rendered unpatentable by that reference.

With respect to the Meyer *et al*, that reference mentions only silicic acids, does not mention organo-silicon compounds and more importantly does not teach or suggest hydrothermal aging of the compound in an aqueous-acidic environment. Accordingly, while the Meyer *et al* reference may disclose a catalyst carrier, it is clear that it cannot be the product obtained by applicant's process. Perhaps, more to the point, in the absence of any

hydrothermal aging, the product of Meyer *et al* would not be a dispersable alumino-silicate much less one as set forth in Claim 35.

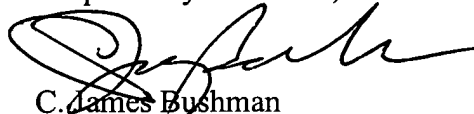
The White reference, like Meyer *et al*, does not teach any hydrothermal aging in an aqueous-acidic environment, nor is there any suggestion in the White reference that the catalyst carrier is dispersable. Accordingly, Claim 35, *prima facie*, claims a product different from that disclosed in White, *et al*.


Lastly, with respect to Nowek *et al*, that reference is merely cumulative of Meyer *et al* and White *et al* in the sense that it does not teach organosilicon compounds and more specifically the hydrothermal aging in an aqueous-acidic environment. Nor does Nowek *et al* like Meyer *et al* and White *et al* disclose that such a product has any dispersability. It is respectfully submitted that the composition of Claim 35 is clearly patentable over EP162, Meyer *et al*, White *et al*, or Nowek *et al*, alone or in combination.

An overall review of the references reveals that none teach or suggest a process, such as set forth in Claim 42 that (1) employs the claimed aluminum compound/silicon compound ratio, (2) teaches hydrothermal aging of the alumino-silicate in an aqueous or aqueous-acidic media at a temperature from 80 to 220°C for a period of time of greater than 0.5 hour, and (3) produces a dry powder which is dispersable in a aqueous/aqueous-acidic media to greater than 90% wt. after drying. In short, the references, taken singularly or combined, simply do not make that a *prima facie* case of obviousness much less anticipation of any of the claims.

In view of the foregoing amendment and remarks, it is respectfully submitted that all claims are in condition for allowance which is earnestly solicited.

Respectfully submitted,

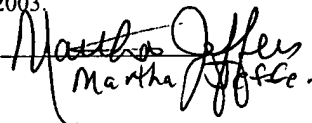

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CERTIFICATE OF FIRST CLASS MAILING

I, Martha Jeffers, hereby certify that this correspondence and all referenced enclosures are being forwarded by me to the U.S. Commissioner for Patents and Trademarks, U.S. Patent and Trademark Office on November 7th, 2003.

Signed:


Martha Jeffers

Remarks

Per a teleconference with the Examiner, whose courtesy is greatly appreciated, all of pending claims 37-52 have been cancelled in favor of newly presented claims 53-72. As was explained to the Examiner, Applicants inadvertently filed claims that were the subject matter of Application Serial No. 09/269,992. The disclosures of the applications are closely related; however, for a point of reference, Applicants would call the Examiner's attention to the translation that was filed on May 1, 2000, and specifically to page 6 thereof wherein in lines 12-15, the ratio of $\text{Al}_2\text{O}_3:\text{SiO}_2$ is recited as being from 99.5 wt. %:0.5 wt. % to 50 wt. %:50 wt. %. This differs from the claims of Application Serial No. 09/269,992 presently on file, which recite that this ratio can be 99.5 wt. %:0.5 wt. % to 70 wt. %:30 wt. %. In any event, the newly presented claims find support, as to the alumina/silica ratio on page 6 of the disclosure as filed on May 1, 2000. The error in filing the wrong claims is sincerely regretted.

Enclosed herewith is a supplemental Information Disclosure Statement containing English translations of JP 01-197311 and JP 04-263,614. Applicant requests that the references be considered.

With respect to the oath/declaration, the title has been amended to recite "Process for the Manufacture of Dispersible Alumino-Silicates," the title of the translation submitted on May 1, 2001. With that amendment to the title, it is respectfully submitted that the oath is in order.

The rejections under § 112 have been mooted by a cancellation of the claims presently on file in lieu of new claims 53-72.

With respect to the art rejections, it is respectfully submitted that new claims 53-72 are not anticipated by Noweck 6,030,599 (hereinafter "Noweck '599"). The Examiner refers to column 13, lines 15-25 for a teaching by Noweck '599 that an aqueous alumina suspension may be combined with a silica compound. In column 13, lines 40-50 of Noweck '599, it is taught that

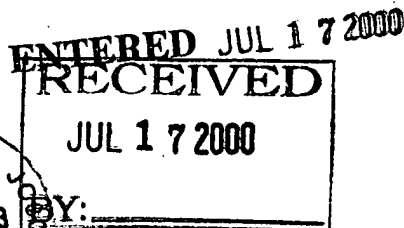
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In re Application of
Andrea BRASCH, et al.
Application No.: 09/269,989
PCT No.: PCT/DE97/02251
Int. Filing Date: 27 September 1997
Priority Date: 05 October 1996
For: METHOD FOR PRODUCING
DISPERSIBLE ALUMINO-SILICATES

COMMUNICATION
RE
NOTIFICATION OF
ABANDONMENT

This communication is to inform applicants that the Notification of Abandonment (Form PCT/DO/EO/909) issued by the Office on 09 May 2000 is VACATED for the following reason:

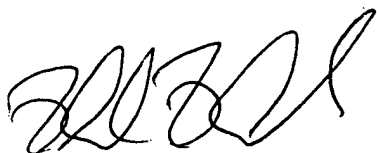
On 01 May 2000, applicants timely filed a Response to the Notification of Missing Requirements of 01 March 2000 by filing a Petition for Extension of Time Under 37 CFR 1.136(a) and submitting the required petition fee of \$110.00. Accordingly, the Notification of Abandonment of 09 May 2000 indicating that applicants have failed to respond to the Notification of Missing Requirements of 01 March 2000 was issued in error and is hereby VACATED.

A review of the translation submitted with the Response reveals that all the objections mentioned in the Office decision of 31 January 2000 and in the Notice of 01 March 2000 have been satisfied, and therefore all the requirements under 35 U.S.C. 371(c) have been submitted.

Applicants' claim for priority is acknowledged. The application has an international filing date of 27 September 1997 under 35 U.S.C. 363 and a date of 01 May 2000 under 35 U.S.C. 371(c) and 102(e).

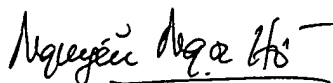
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The application is being returned to the United States Designated/Elected Office for further processing, including the issuance of a Notification of Acceptance (Form PCT/DO/EO/903) with a 35 U.S.C. 371(c) and 102(e) date of **01 May 2000**.



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